



DAC

PATENT

Attorney Docket No. AMBER-06803

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Kenneth J. Rothschild *et al.*

Serial No.: 10/034,736

Group No.:

Filed: 12/27/01

Examiner:

Entitled: **Detection Of Markers In Nascent Proteins**

**Transmittal**

Commissioner for Patents

Box DAC

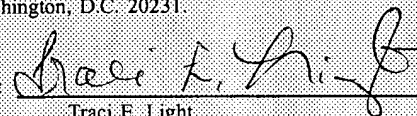
Washington, D.C. 20231

**CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8(a)(1)(i)(A)**

I hereby certify that this correspondence (along with any referred to as being attached or enclosed) is, on the date shown below, being deposited with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

Dated: October 18, 2002

By:



Traci E. Light

Sir or Madam:

Enclosed herewith please find the following:

1. Request for Reconsideration of Petition Under 37 CFR 1.47(a).
2. Declaration for patent application.
3. Power of Attorney by Assignee.
4. Copy of Decision Refusing Status Under 37 CFR 1.47(a).

The Commissioner is hereby authorized to charge any additional fee or credit overpayment to our Deposit Account No. 08-1290. An originally executed duplicate of this transmittal is enclosed for this purpose.

Dated: October 18, 2002



Thomas W. Brown  
Registration No. 50,002

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OCT 25 2002

OFFICE OF PETITIONS

MEDLEN & CARROLL, LLP  
101 Howard Street, Suite 350  
San Francisco, California 94105  
617.252.3353



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**PATENT**

Attorney Docket No. AMBER-06803

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**In re Application of: Kenneth J. Rothschild *et al.*

Serial No.: 10/034,736

Group No.:

Filed: 12/27/01

Examiner:

Entitled: **Detection Of Markers In Nascent Proteins****Request For Reconsideration Of Petition Under  
Under 37 CFR 1.47(a)**Commissioner for Patents  
Box DAC  
Washington, D.C. 20231

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I hereby certify that this correspondence (along with any referred to as being attached or enclosed) is, on the date shown below, being deposited with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.	
Dated: <u>October 18, 2002</u>	By: <u>Traci E. Light</u> Traci E. Light

Sir or Madam:

In the "Decision Refusing Status Under 37 CFR 1.47(a)" (mailed August 19, 2002), the Supervisory Petitions Examiner noted that Applicants did not provide, with their Petition To Accept Application Under 37 CFR § 1.47 (mailed April 22, 2002), an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116. That is to say, the Declaration that was originally filed on April 22, 2002 did not recite the name, citizenship, and mailing address of the Dr. Sanjay M. Sonar; the named inventor whose failure to respond has necessitated the filing of the instant petition.

Applicants hereby submit the attached Declaration which includes the name, address and citizenship of all the named inventors; including Sanjay M. Sonar who, to this day, has not responded to our correspondence soliciting his signature of documents required for the prosecution of the above captioned patent application. Please note that the remaining inventors (Kenneth J. Rothschild and Jerzy Olejnik) have signed and dated the attached Declaration.

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OCT 25 2002

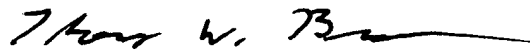
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Therefor, Applicants respectfully request that the instant "Request For Reconsideration Of Petition Under 37 CFR 1.47(a)" be granted given that the Applicants have: 1) provided proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); 2) provided an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; 3) paid the petition fee and 4) have provided a statement of the last known address of the non signing inventor (e.g. Dr. Sonar).

The Commissioner is hereby authorized to charge any additional fee or credit overpayment to our Deposit Account No. 08-1290. **An originally executed duplicate of this transmittal is enclosed for this purpose.**

Respectfully submitted,

Dated: October 18, 2002



Thomas W. Brown  
Registration No. 50,002

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San Francisco, California 94105  
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OFFICE OF PETITIONS

MEDLEN & CARROLL, LLP  
101 Howard Street, Suite 350  
San Francisco, CA 94105

In re Application of  
Rothschild et al.  
Application No. 10/034,736  
Filed: December 27, 2001  
Attorney Docket No. AMBER-06803

DECISION REFUSING STATUS  
UNDER 37 CFR 1.47(a)

This is in response to the petition, filed May 1, 2002 (certificate of mailing date April 22, 2002), under 37 CFR. §1.47(a).

The petition under 37 CFR. §1.47(a) is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS <sup>-10/19/02 RLO</sup> from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR. §1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 CFR. §1.136(a).

The above-identified application was filed on December 27, 2001, without an executed oath or declaration. Accordingly, on February 22, 2002, applicant was mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted," requiring an executed oath or declaration in compliance with §1.63, and a surcharge for its late filing. This Notice set an extendable two-month period for reply of April 22, 2002.

In reply, applicant filed a petition, the surcharge for late filing of the declaration, and a partially executed declaration. In support of the petition, petitioner has provided copies of correspondence mailed to non-signing inventor.

A grantable petition under 37 CFR. §1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. The instant petition does not satisfy requirement (2).

As to item (2), the declaration submitted is not in compliance with 37 CFR 1.63. Rule 47 applicant failed to provide the citizenship and mailing addresses of all of the inventors pursuant to 37 CFR 1.63 (a)(3) and (c)(1). Petitioner failed to provide the name, address or citizenship of inventor Sanjay M. Sonar. Upon renewed petition, a executed oath or declaration with all inventors information must be provided.

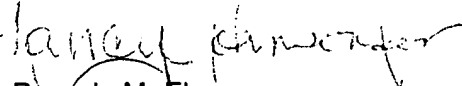
Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents  
Box DAC  
Washington, D.C. 20231

By FAX: (703) 308-6916  
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23  
2201 S. Clark Place  
Arlington, VA 22202

Telephone inquiries related to this decision may be directed to Petitions Attorney Charlema R. Grant at (703) 306-0251.

  
Beverly M. Flanagan  
Supervisory Petitions Examiner  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy